

REMARKS

Claims 1-46 are pending in the application. Claims 1-7, 9-16, 18-27, 29-42 and 44-46 are rejected. Claims 8, 17, 28 and 43 are objected to.

35 U.S.C. § 103:

Claims 1, 2, 9-11, 18, 19, 29, 30, 32, 33, 34, 44 and 45 are rejected under 35 U.S.C. § 103(a) as being anticipated by Wang et al. (U.S. Pub. No. U.S. 2003/0191368 [hereinafter “Wang”]). Independent claims 1, 9, 18 and 32 recite that said tissue-state image and said tissue-form image are initially separate images. This feature is not taught or suggested by the prior art. The grounds of rejection assert that such a feature is a “design choice.” (see Office Action, page 2). Applicant strenuously disagrees.

The feature regarding “initially separate images” is not a “design choice.” Instead, this feature is an explicitly required element of independent claims 1, 9, 18 and 32, which distinguishes these claims from the prior art. Wang does not teach or suggest, *inter alia*, the “initially separate images” feature founding claims 1, 9, 18 and 32.

Claim 1 recites, *inter alia*,

“assigning to said fluorescent-light image at least one of color data and brightness data corresponding to the at least one of color data and the brightness data assigned to said tissue-state image and forming a tissue-form image representing mainly the form of the tissue in the target area, such that said tissue-state image and said tissue-form image are initially *separate images...*” (Emphasis added.)

Claim 9 recites a similar feature. Likewise, independent claims 18 and 32 recite similar features while using “means” language.

For example, the exemplary, non-limiting embodiment of present Figure 4 shows a tissue-state image forming means 131 that provides the tissue-state image; and a tissue-form

image forming means 132 that provides the tissue-form image. Thus, the tissue state image is originally separate from the tissue-form image. The application of Wang does not disclose this feature because the alleged image formed by the contour lines and the filled in areas of Wang are not taught or even suggested as being separate, but instead are provided together to form a final image, such that the rejection of claims 1, 9, 18 and 32 should be withdrawn.

Also, the assertion of “design choice” in the Office Action acknowledges the references’ failure to teach or suggest each feature found in the claims (see page 2, Office Action dated October 12, 2006). The Examiner is presumably referring to MPEP §2144.04 that discusses an “rearrangement of parts,” and cites *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950), where claims to a hydraulic power press, which read on the prior art except with regard to the position of the starting switch, were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device. If the Examiner is relying on any alternative authority, Applicant respectfully requests the Examiner to provide such authority (i.e. statute, case law, section of MPEP, etc.).

The above-noted feature regarding “separate images” is not a mere rearrangement of parts. Instead, this feature is absent from Wang and absent features cannot be rearranged regardless of any teaching or suggestion.

Further, to establish a *prima facie* case of obviousness, there must be established, *inter alia*, that there was some suggestion or motivation to modify the reference so as to obtain the recited features (See MPEP §2143.) The Examiner has the burden of establishing a *prima facie* case of obviousness. This burden can only be satisfied by an objective teaching in the prior art or by cogent reasoning that the knowledge is available to one of ordinary skill in the art. See *In*

re Lalu, 747 F.2d 703 (Fed. Cir. 1984). Wang does not teach or suggest the claimed features or provide motivation to derive the features and the grounds of rejection ignore the fundamental requirements of establishing a *prima facie* case of obviousness.

Moreover, as noted in MPEP §2143.01, “THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION.” In this case, the prior art does not suggest the desirability of the claimed invention. No where do the references provide a teaching or suggestion of any desirability to provide a fluorescent-light image display method and apparatus including the “separate images” feature as required by the claims. Thus, there is no actual basis to support a legal conclusion of obviousness.

In view of the many reasons present above, it should be understood that Wang does not teach or suggest each feature recited in claims 1, 9, 18 and 32, such that the rejection thereof under 35 U.S.C. § 103(a) should be withdrawn. The rejection of dependent claims 2, 10, 11, 19, 29, 30, 33, 34, 44 and 45 should also be withdrawn at least by virtue of these claims respectively depending upon independent claims 1, 9, 18 and 32.

Claims 3-6, 12-15, 20-26 and 35-41 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wang in view of Kaneko (U.S. Patent No. 6,422,994).

Kaneko is cited for allegedly disclosing to assign display gradation based on maximum value and frequency (histogram) of the brightness levels of the image signals to indicate a normal or non-normal tissue (see col. 17, lines 3-20 of Kaneko). Applicant submits that Kaneko fails to make up for the deficient teachings of Wang and Tsujita, such that the rejection of the dependent claims should be withdrawn at least by virtue of these claims respectively depending from independent claims 1, 9, 18 and 32.

Claims 7, 16, 27 and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wang in view of Zeng et al. (U.S. Patent No. 5,647,368).

Claims 31 and 46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wang in view of Hayashi et al. (U.S. Patent No. 6,433,345).

The additional application of Zeng et al. and Hayashi et al. fails to supplement the deficient teachings of Wang in regard to independent claims 1, 9, 18 and 32. Thus, claims 7, 16, 27, 31, 42 and 46 are deemed patentable over the applied references at least by virtue of their respective dependencies on the independent claims.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

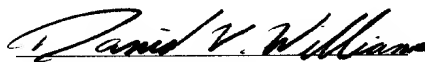
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